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DEC 15 2009

In re Patent No. 7,527,336
Issued: May 5, 2009
Application No. 10/549,554
Filed: September 19, 2005
Dkt. No.: 026032-4923

OFFICE OF PETITIONS

PATENT TERM ADJUSTMENT

This is a decision on the “REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705,” filed March 26, 2009. Patentees request correction of the patent term adjustment from 399 days to 697 days. Patentees requested this correction on the sole basis that the Office would take in excess of three years to issue the above-referenced patent. This matter is being properly treated under 37 CFR 1.705(d).

The application for patent term adjustment (PTA) under 37 CFR 1.705(d) is **DISMISSED**.

An application for patent term adjustment was timely filed March 26, 2009 in the above-identified application. However, prior to a decision on the merits of the application for patent term adjustment, the above-identified application matured into U.S. Pat. No. 7,527,336 on May 5, 2009. The patent issued with a patent term adjustment of 399 days. Applicants argued that in view of Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008), the patent was entitled to an adjustment of 697 days (429 days pursuant to 35 USC 154(b)(1)(A) *plus* 298 days pursuant to 35 USC 154(b)(1)(B) *less* 30 days applicant delay). The application for patent term adjustment was predicated on a projected patent issuance date of July 14, 2009.

Under 37 CFR 1.703(f), patentees are entitled to a period of patent term adjustment equal to the period of delays based on the grounds set forth in 37 CFR 1.702 reduced by the period of time equal to the period of time during which patentees failed to engage in reasonable efforts to conclude prosecution pursuant to 37 CFR 1.704. In other words, patentees are entitled to the period of Office delay reduced by the period of applicant delay.

The Office asserts that as of the issuance of the patent on May 5, 2009, the application was pending three years and 228 days after national stage commenced under 35 U.S.C. 371(b) or (f) in an international application. The Office agrees that certain action was not taken within the specified time frame, and thus, the adjustment of 429 days pursuant to 37 CFR 1.702(a)(1) is correct. At issue is whether patentees should accrue 228 days of patent term adjustment for the Office taking in excess of three years to issue the patent, as well as 429 days for Office failure to take a certain action within a specified time frame (or examination delay).

The Office contends that the period of 228 days of delay in issuance of the patent under 37 CFR 1.702(b) overlaps with the period of 429 days of examination delay under 37 CFR 1.702(a)(1). Patentees' calculation of the period of overlap is inconsistent with the Office's interpretation of this provision. 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

To the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f)¹ and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 54366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004).

Further, as stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after national stage commence, is the relevant period under 35

¹ Likewise, 37 CFR 1.703(f) provides that:

To the extent that periods of delay attributable to the grounds specified in §1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

U.S.C. 154(b)(1)(B) in determining whether periods of delay “overlap” under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding §1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay “overlap” under 35 U.S.C. 154(b)(2)(A) is the period during which the application was pending before the Office beginning on the date that national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, September 19, 2005, and ending on the date that the patent issued, May 5, 2009.

Pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a)(1), the application was pending 14 months and 429 days prior to the issuance of the non-final Office action on January 22, 2008. Pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b), the application was pending three years and 228 days prior to the issuance of the patent on May 5, 2009.

The 228 days of delay in issuance of the patent under 37 CFR 1.702(b) overlap with the 429 days of patent term adjustment under 37 CFR 1.702(a). Entry of both the 228 days and the 429 days is neither permitted nor warranted given that 429 days is the actual number of days issuance of the patent was delayed.

Accordingly, at issuance, having considered the 228 days of Office delay under the three-year pendency provision in conjunction with the 429 days of examination delay, reduced 30 days for applicant delay, the Office properly entered 399 days of patent term adjustment.

In view thereof, no adjustment to the patent term will be made.

Receipt is hereby acknowledged of the required patent term adjustment application fee of \$200.00.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3205.



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